

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-7, 9, 10, 12-15, 17, and 18 are currently pending. Claims 8 and 16 have been cancelled without prejudice; and Claims 1, 2, 8-10, 12, and 15-18 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-3, 5, 8-10, 12, and 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,378,887 to Kobayashi (hereinafter “the ‘887 patent”) in view of U.S. Patent Application Publication No. 2002/0188852 to Masaki et al. (hereinafter “the ‘852 application”); Claims 6, 7, 13, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘887 patent and the ‘852 application, further in view of U.S. Patent No. 6,351,845 to Hinker et al. (hereinafter “the ‘845 patent”); and Claim 4 was rejected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Amended Claim 1 is directed to an information processing apparatus having embedded therein a non-contact type IC, the information processing apparatus comprising: (1) communicating means for communicating data with the non-contact type IC via data lines, the non-contact type IC including a memory, a memory control unit, and an antenna that are independent of the information processing apparatus; (2) detecting means for detecting any access to the non-contact type IC; (3) determining means for determining whether a result of detection by the detecting means indicates internal access by the communicating means of the information processing apparatus or external access from an external apparatus external to the information processing apparatus; and (4) access controlling means for controlling the external access from the external apparatus when the

determining means determines that the result of detection by the detecting means indicates the external access from the external apparatus. The changes to Claim 1 is supported by the originally filed specification and do not add new matter.¹

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the '887 patent discloses everything in Claim 1 with the exception of an information recording medium comprising a memory, a control unit, and an antenna, and relies on the '852 application to remedy that deficiency.

The '887 patent is directed to a non-contact type IC card that communicates signals with an external device in a non-contact manner, including a main circuit 16 that conducts various operations based on functions of the IC card, means for creating an operation inhibit signal to inhibit operation of the main circuit for a predetermined period of time, and a control means for controlling the main circuit and the operation inhibition signal generating means. Further, the '887 patent discloses that the main circuit 16 is inhibited for a predetermined period of time after the operation of the main circuit is completed to prevent a double write operation of history in the IC card due to re-access in a short period of time following an initial access. As shown in Figure 5, the '887 patent discloses an IC card having a memory 32 having two memory areas 321 and 322, a memory control section 36, a read area deciding section 34, and a modulating and demodulating section 38. The '887 patent discloses that the read area deciding section 34 determines from which one of the two areas 321 and 322 of the memory data is to be read. Further, the '887 patent discloses that the memory control section 36 controls writing to and reading from the memory 32, wherein the memory control section writes to or reads from either area 321 or area 322 based on information provided by the read area deciding section 34. Thus, the purpose of the '887 patent non-contact IC card shown in Figure 5 is to prevent erroneous history information

¹ See, e.g., Figure 2 and the discussion related thereto in the specification.

from being written into the memory 32 when a user of the card enters an area accessible to a reader/writer two or more times in quick succession.

Regarding the elements recited in Claim 1, the Office Action relies on the IC card 30 shown in Figure 5 as reading on the claimed information processing apparatus.² Further, the Office Action relies on elements 32, 36, 38, and 40 of the IC card shown in Figure 5 of the '887 patent as reading on the previously claimed information recording medium. Applicant notes that the present claims have been amended to recite an non-contact type IC rather than an information recording medium. Further, the Office Action states that the claimed communication means are read on by the "data path connecting elements 32 to 34 and 34 to 36." Further, the Office Action relies on the memory control section 36 as reading on the claimed detecting means, and also relies on the memory control section and the read area deciding section as shown in Figure 5 of the '887 patent as reading on the claimed determining means. Finally, the Office Action appears to rely on the circuit setting time for inhibition of re-access circuit 12 shown in Figure 2 as reading on the claimed accessing control means.

Applicant notes that, as recited in Claim 1, the claimed elements of the information processing apparatus are (1) a communicating means, (2) a detecting means, (3) a determining means, and (4) an access control means. Thus, as claimed, the memory, the memory control unit, and the antenna of the non-contact type IC are separate and independent elements from the communicating means, detecting means, determining means, and access control means of the information processing apparatus, in which the non-contact type IC is embedded. In this regard, Applicant notes that the Office Action states that the claimed detecting means is read on by the memory control section 36 shown in Figure 5 of the '887 patent. However, Applicant notes that the Office Action has previously stated that elements

² See the last line on page 2 of the outstanding Office Action.

32, 36, and 38 comprise the information recording medium (non-contact type IC) recited in the claims. Given that the non-contact type IC is separate from the claimed information processing apparatus, *it is unclear to Applicant how the memory control section 36 can at the same time be part of the claimed non-contact type IC (information recording medium) and the claimed information processing apparatus*, wherein Claim 1 clearly states that the non-contact type IC is independent of the information processing apparatus. Applicant respectfully submits that it cannot, and thus respectfully that the '887 patent fails to disclose the detecting means recited in Claim 1.

Further, Applicant respectfully submits that the '887 patent fails to disclose the communicating means recited in Claim 1. Amended Claim 1 recites communicating means for communicating data with the non-contact type IC via data lines. Thus, the data lines connecting elements 32 and 34, and 34 and 36 shown in Figure 5 of the '887 patent might be able to read on the data lines recited in Claim 1, but not on the communicating means recited in Claim 1.

Further, Applicant respectfully submits that the '887 patent fails to disclose the determining means recited in Claim 1. On page 3 of the outstanding Office Action, the Office Action states that access to the IC card can occur from a write operation via an external device. Alternatively, the Office Action precedes to state that the access can simply result from reading of the memory via the read area deciding section. Further, the Office Action asserts that "...the memory control section is capable of making a determination of where the access is coming from – more specifically, the read area deciding section is used to decide which area of the memory 32 should be accessed."³ However, Applicant notes that the read area deciding section is only related to the writing and reading of information to the memory 32. Applicant respectfully submits that *the '887 patent does not disclose that the*

³ See page 4 of the outstanding Office Action.

memory control section makes a determination of whether the access is internal or external to the IC card 30. While Applicant agrees that the memory control section is “involved” in having information written to and read from the memory 32, the ‘887 patent does not disclose that the memory control section makes the determination recited in the claims. In essence, the Office Action is arguing that there exists some type of internal access to the memory and some type of external access to the memory. Even assuming *arguendo* that both types of access are disclosed by the ‘887 patent, this is not the same as a disclosure that any element disclosed by the ‘887 patent determines whether a result of detection by a detecting means indicates internal access or external access. The claims require that when there is a detection of an access, it is determined whether that detection indicates an internal access or external access. *No unit in the ‘887 patent makes a determination as to whether a particular access is internal or external.* Moreover, Applicant notes that the Office Action has stated that element 36 is part of the information recording medium (non-contact type IC) recited in the claims. Thus, it is unclear to Applicant how the memory control section 36 can also be the determining means recited in the claims, wherein the determining means is part of the information processing apparatus, and the claims clearly state that the non-contact type IC is independent of the information processing apparatus. If the memory control section 36 is part of the claimed non-contact type IC, it cannot be part of the claimed information processing apparatus, i.e., be the determining means recited in the claims.

Further, Applicant respectfully submits that the ‘887 patent fails to disclose the accessing control means recited in Claim 1. In this regard, Applicant notes that the Office Action has equated the memory control section 36 and/or the read area deciding section 34 as reading on the claimed determining means. Claim 1 requires that when the determining means determines that the result of detection by the detecting means indicates external access, the access controlling means controls the external access. The Office Action appears

to equate the circuit 12, which determines the inhibition time for inhibiting re-access, as reading on the claimed access controlling means. However, Applicant notes that the '887 patent does not disclose that the circuit 12 controls external access when the memory control section 36 or the read area deciding section 34 determines that the result of the detection is external access. In this regard, Applicant notes that the circuit 12 executes the process shown in Figure 4 of the '887 patent, and that the process is not conditioned upon the detection of whether access is internal or external by the elements of the circuit 16, which include the memory control section 36 and the read area deciding section 34.

The '852 application is directed to a monitoring apparatus that monitors access to a memory area of an IC card. In particular, the '852 application discloses an IC card 101 having a CPU 102, a ROM 103, a RAM 104, and an EEPROM 105. Further, the '852 application discloses an access monitoring means 110 that monitors access to particular memory area of the ROM 103 and the RAM 104. Further, Applicant notes that the Office Action appears to rely on the '852 application as disclosing a memory, a monitoring circuit and a memory manager in a single integrated circuit card.

However, Applicant respectfully submits that the '852 application fails to remedy the deficiencies of the '887 patent, as discussed above. In this regard, Applicant notes that the '887 patent also discloses an IC card 30 having a memory, a memory control section and an antenna integrated on a single card.

Thus, no matter how the teachings of the '887 patent are combined, the combination fails to teach or suggest the communicating means, the determining means, the detecting means, and the access controlling means recited in Claim 1. Accordingly, Applicant respectfully traverses the rejection of Claim 1 under 35 U.S.C. § 103.

Further, Applicant notes that the Office Action fails to provide any motivation for combining the teachings of the '887 patent and the '852 application. In this regard, Applicant

notes that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning or some rational underpinning to support their legal conclusion of obviousness.”⁴ Here, the Office Action has provided no articulated reasoning for combining the teachings of the ‘887 patent and ‘852 application. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and that the rejection of Claim 1 should be withdrawn.

Independent Claims 9, 10, 12, 17, and 18 recite limitations analogous to the limitations recited in Claim 1. Moreover, Claims 9, 10, 12, 17, and 18 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 1, Applicant respectfully traverses the rejection of Claims 9, 10, 12, 17, and 18.

Regarding the rejection of dependent Claims 6, 7, 13, and 14 under 35 U.S.C. § 103, Applicant respectfully submits that the ‘845 patent fails to remedy the deficiencies of the ‘887 patent and the ‘852 application, as discussed above. Accordingly, Applicant respectfully traverses the rejection of Claims 6, 7, 13, and 14.

Thus, it is respectfully submitted that independent Claims 1, 9, 10, 12, 17, and 18 (and all associated dependent claims) patentably define over any proper combination of the ‘887 patent, the ‘852 application, and the ‘845 patent.

⁴ In Kahn, 441 F.3d 977, 988 (CA Fed. 2006) cited with approval in KSR Int’l v. Teleflex Inc.

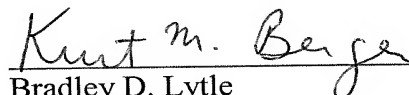
Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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